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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,043	10/17/2001	Hans Gude Gudesen	2834-0133P	4358

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EXAMINER

MONDT, JOHANNES P

ART UNIT PAPER NUMBER

2826

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/978,043

Applicant(s)

GUDESEN ET AL.

Examiner

Johannes P Mondt

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/381,994.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Information Disclosure Statement*

The examiner has considered the items listed on the Information Disclosure Statement of Paper No. 4 with the exception of Hua et al, Vacuum 43, 11: 1019-1023 (1992) which (a) was not found in the file and (b) is not otherwise available at this time to the examiner. Applicant is kindly requested to provide a copy of said item.

### *Claim Objections*

1. **Claim 11** is objected to because of the following informalities: the verbiage "is provided" (line 2) should be replaced by "are provided. Appropriate correction is required.
2. **Claims 14 and 15** are objected to because of the following informalities: the verbiage " $\mu$ m" (lines 3 for both claims, occurring there twice in both claims) should be replaced by " $\mu$ m" throughout. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 10, 16 and 18** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the



invention. In particular, the verbiage "point, line and/or area potential created between selected electrodes" (claim 10, line 25; claim 16, line 22) and the verbiage "electric point or line potentials" (claim 18, lines 3 and 6) lack enablement considering the specification because no delineation within the specification can be found within the context of which the potential created by said selected electrodes can be approximated as being of a lower dimension than said selected electrodes, which are intrinsically three-dimensional.

3. **Claims 11-15 and 17-22** are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because of their dependence on independent claims 10 and 16 that have been rejected under 35 U.S.C. 112, first paragraph.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claim 10** recites the limitation "the electrodes" in line 15. There is insufficient antecedent basis for this limitation in the claim.

2. **Claim 10** recites "matrix-like (line 16), which is a relative term that renders the claim indefinite. The term "matrix-like" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

3. **Claim 10** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. In particular, the verbiage "conduction mode" (line 8) is nowhere defined, either in the claim or in the specification as a whole.

4. **Claim 10** recites the limitation "cross-connection devices" (in line 17). There is insufficient antecedent basis for this limitation in the claim.

5. **Claim 11** recites the limitation "the electrodes" in line 2. There is insufficient antecedent basis for this limitation in the claim.

6. **Claim 16** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the verbiage "conduction mode" (line 8) is nowhere defined, either in the claim or in the specification as a whole.

7. **Claim 16** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the verbiage "matrix-like" (line 16) renders the claim indefinite.

8. **Claim 16** recites "matrix-like" (line 16), which is a relative term that renders the claim indefinite. The term "matrix-like" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

9. **Claim 16** recites the limitation "the electrodes" (in line 15). There is insufficient antecedent basis for this limitation in the claim.

10. **Claims 11-15 and 17-22** are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention because of their dependence on independent claims 10 and 16 rejected under 35 U.S.C. 112, second paragraph.

11. **Claim 18** recites the limitation "the layer" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

12. **Claim 18** recites the limitation "the electrodes" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

13. **Claim 19** recites the limitation "the thin-film material" in lines 2 and 5. There is insufficient antecedent basis for this limitation in the claim.

14. **Claim 19** recites the limitation "the electrode devices" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

15. **Claim 19** recites the limitation "the rolls" in line 4. There is insufficient antecedent basis for this limitation in the claim.

16. **Claim 20** recites the limitation "the thin-film material" in line 2. There is insufficient antecedent basis for this limitation in the claim.

17. **Claim 22** recites the limitation "each separate material layer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P Mondt whose telephone number is 703-306-0531. The examiner can normally be reached on 8:00 - 18:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J Flynn can be reached on 703-308-6601. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JPM

September 5, 2003

  
NATHAN J. FLYNN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800